

REMARKS

Claims 32 and 47-49 were rejected under 35 U.S.C. §103 (a) as being obvious over Pinho et al US 2002/0056707 ("Pinho") in view of Yamada et al US 5,540,998 ("Yamada"). The applicants respectfully traverse these rejections.

The applicants appreciate that the Examiner has acknowledged that claims 33-36 and 38-46 are allowable over the prior art.

PRIOR ART REJECTIONS

Claims 32 and 47-49 were rejected under 35 U.S.C. §103 (a) as being obvious over Pinho in view of Yamada. The applicants respectfully traverse this rejection.

The applicants inadvertently thought that their priority document antedated Pinho. The Examiner is correct that the applicants' priority document does not antedate Pinho. The applicants apologize for this misstatement and appreciate the Examiner correcting the applicants.

The applicants' claimed invention is directed to a black thermoplastic molding composition which comprises a **dye combination** made from **nonabsorbing polymer-soluble yellow dye** and nonabsorbing **polymer-soluble violet dye** which is translucent or transparent to laser light (see claim 32).

Pinho is directed to a different technology than the applicants' claimed invention. Pinho is directed to thermoplastic substrates used to make carpet panels. A laser is used to weld a plastic substrate material to an adjacent material, such as synthetic carpet panel

(see the abstract). Pinho as the Examiner correctly stated, discloses in paragraph no. 32, mixing dyes of the primary colors red, yellow and blue. However, Pinho does not disclose nor teach using the applicants' claimed combination of nonabsorbing polymer-soluble yellow dye and nonabsorbing **polymer-soluble violet dye**. There is no teaching to use a nonabsorbing **polymer-soluble violet dye as is claimed by the applicants**. In addition, the applicants' claimed invention is drawn to a black thermoplastic molding composition and not thermoplastic substrates used to make carpet panels.

Yamada is directed a solar heat shielding **coating composition** and coated structure which consists mainly of two kinds or more of pigments selected from red, orange, yellow, green, blue and purple pigments in such a manner as to yield a color of low lightness, particularly achromatic black (see the abstract). It is acknowledged that Yamada discloses combining two pigments yellow and violet in Example 4, but as the Examiner has correctly recognized the applicants' claimed invention is requires combining **dye combination** made from **nonabsorbing polymer-soluble yellow dye** and nonabsorbing **polymer-soluble violet dye**. Dyes, let alone **nonabsorbing polymer-soluble yellow dye** and nonabsorbing **polymer-soluble violet dye** are not taught by Yamada. Another difference is that Yamada is directed to a coating composition and not a molding composition as is required by the applicants' claimed invention. There would be no reason to combine Yamada (solar heat shielding coating composition) with Pinho (welding of carpet panels).

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed

multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** is suggested by the prior art (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d.

1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Pinho in view of Yamada. For the above reasons, this rejection should be withdrawn.

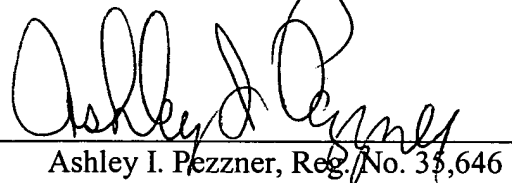
A one-month extension fee has been paid. No additional fees are due. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an extension is requested and the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

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By



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